

## **REMARKS**

Claims 1-20 are all the claims pending in the application. The Examiner rejects claims 1-2, 4-5, and 7 under 35 U.S.C. §103(a) as being unpatentable over Klopfenstein (US 6,985,190), and claims 6, 11-14, and 18 as being unpatentable over Klopfenstein in view of Iwamura (US 5,940,028). Claims 9-10 and 15-16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Klopfenstein. Claim 17 stands rejected under 35 U.S.C. §102(e) as being anticipated by Iwamura. Claims 3, 8, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant amends claims 9 and 17, and cancels claims 15, 16, and 20. No new matter has been added.

Applicant appreciates the acknowledgment of foreign priority under 35 U.S.C. §119 and of the allowable subject matter of claims 3, 8, 19.

### **§ 103(a) Rejection Klopfenstein Reference**

Claims 1-2, 4-5, and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Klopfenstein. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See, MPEP 2143.

### Claims 1 and 7

The present invention and Klopfenstein are each directed to an apparatus and method for measuring the broadcast signal strength of each channel of a broadcast receiver and displaying the signal strength of each channel on a display for the purpose of orienting an antenna. The application sums the signal strengths and displays the sum. Klopfenstein does not.

To establish a *prima facie* case of obviousness, the Examiner must show that there is a suggestion or motivation to modify the reference. Here the Examiner rejects independent claims 1 and 7 citing Klopfenstein as teaching all the limitations of claims 1 and 7 except the limitation of summing and displaying the sum of the signal strengths of the individual channels. The Examiner states that displaying the sum of the signal strengths "would be obvious to the skilled in the art in that it would simply involve adding ... each signal strength." The Examiner does not, however, state the reasoning that provides the motivation to modify Klopfenstein by summing and displaying the sum of the individual signal strengths.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See, MPEP 2143.01 (III). Applicant agrees that Klopfenstein can be modified to sum and display the sum of the individual signal strengths, but Klopfenstein did not do so, and Klopfenstein did not provide any motivation to do so. Instead, Klopfenstein teaches away from providing a single number that indicates the combined signal strength of a particular antenna orientation. Klopfenstein teaches that the antenna may be oriented to receive the greatest number of channels that satisfy the minimum signal strength. See, Klopfenstein, col. 4:20-25 ("The Antenna Information process provides real-time signal strength of the received digital signal (e.g., terrestrial or satellite television signals) and helps the user adjust his terrestrial antenna (e.g., antenna 26 of FIG.

1) to receive the greatest number of digital television channels that satisfy a minimum signal strength threshold.") This is quantitatively different than orienting an antenna to maximize the combined signal strength of the received channels. For at least this reason, Klopfenstein teaches away from summing and displaying the sum of the individual channels, and therefore does not provide motivation to modify. Without finding motivation to modify the reference within the reference itself, the *prima facie* case for obviousness must fail.

The fact that the addition of summing and displaying the sum of the individual signal strengths to Klopfenstein is obvious to the skilled practitioner or that summing and displaying the sum of the individual signal strengths was "well within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See, MPEP 2143.01 (IV). As discussed above, Klopfenstein does not provide the required objective reason. The Examiner has only stated that summing and displaying the sum would be obvious to the skilled in the art, but this statement alone does not rise to the required objective reason.

For at least these reasons, applicant believes that claims 1 and 7, as well as all claims dependent therefrom, are allowable over Klopfenstein and respectfully request the Examiner to reconsider and withdraw the rejections.

#### **§ 102(e) Rejection Klopfenstein Reference**

The Examiner has rejected claims 9-10, 15-18, and 20 as being anticipated by Klopfenstein.

#### **Claim 9**

Applicant amends independent claim 9 to include the limitation "wherein the microcomputer displays the channel numbers, the number of channels, signal

strengths of each channel, and the sum of signal strengths of the entire channels." In rejecting claim 1, the Examiner stated Klopfenstein does not teach displaying the sum of the signal strengths of the channels, and the Examiner relied upon obviousness of the skilled in the art to modify Klopfenstein. As discussed above, without more, claim 9 as amended is not obvious over Klopfenstein as modified by knowledge of one skilled in the art.

Applicant asserts that claim 9 as amended is not anticipated by Klopfenstein, nor is claim 9 as amended obvious over Klopfenstein, and is allowable as are all claims dependent therefrom. Applicant respectfully requests reconsideration and withdrawal of the rejection in view of the amendments to claim 9 and the preceding remarks.

#### **§ 102(e) Rejection Iwamura Reference**

The Examiner rejects claim 17 as being anticipated by Iwamura.

#### **Claim 17**

Iwamura is also directed to a system and method for aligning an antenna based upon selected channel signal strengths. Signal strength information is derived from equalizer tap weights and displayed on a display. An installer aligning an antenna may then select the appropriate alignment by viewing the signal strengths being displayed. Iwamura does not sum the signal strengths of the selected channels nor display the sum. Applicant amends claim 17 to include the limitation "wherein the microcomputer controls the decoding unit to display the channel numbers, the number of channels, signal strengths of each channel, and the sum of signal strengths of the entire channels, in an OSD form on a screen" and cancels claim 20.

Because Iwamura does not teach all the limitations of the claim 17 as amended, claim 17 as amended is not anticipated by Iwamura and claim 17 and

all claims depending therefrom are allowable over Iwamura. Applicant respectfully requests reconsideration and withdrawal of this rejection.

**§ 103(a) Rejection  
Klopfenstein and Iwamura References**

The Examiner rejected dependent claims 6, 11-14, and 18 as being obvious over Klopfenstein in view of Iwamura. Each of these claims is now dependent from an allowable independent claim, and for at least this reason is allowable. As discussed *supra*, neither Klopfenstein nor Iwamura, alone or in combination, teach or reasonably suggest all the limitations of the independent claims, namely, summing and displaying the sum of the individual channel signal strengths.

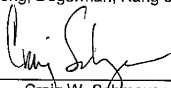
**CONCLUSION**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain at issue which the Examiner feels may be best resolved through a telephone interview, the Examiner is kindly invited to contact the undersigned at (213) 623-2221.

Respectfully submitted,  
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By: \_\_\_\_\_



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